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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,441	06/26/2001	Guy Tabacchi	0503-1082	9635

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EXAMINER	
ARNOLD, ERNST V	
ART UNIT	PAPER NUMBER
1616	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/888,441	TABACCHI ET AL.	
	Examiner	Art Unit	
	ERNST V. ARNOLD	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,11,13,15-18 and 29-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,11,13,15-18 and 29-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 2, 5-10, 12, 14, 19-28 and 33-35 have been cancelled. Claims 1, 3, 4, 11, 13 and 15-18 and 29-32 are pending and under examination.

Withdrawn rejections:

Applicant's amendments and arguments filed 9/15/08 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below is herein withdrawn. Applicant has filed terminal disclaimers which have been approved on 10/10/08. Accordingly, the double patenting rejections are withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 4, 11, 13, 15-18 and 29-32 remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over WO/99/42521 (equivalent in English-US 6,375,959) in view of FR 97- 04876 (English equivalent US 6,353,034) and Chaudrey et al. (US 5,804,202).

Applicant claims a self invertible inverse latex composition comprising an oil phase; aqueous phase; at least one emulsifying agent of water in oil type; at least emulsifying agent of oil in water type and from 20 to 70% by weight of a branched or crosslinked polyelctrolyte.

Determination of the scope and content of the prior art

(MPEP 2141.01)

The references of WO/99/42521 (equivalent in English-US 6,375,959) and FR 97- 04876 (English equivalent US 6,353,034) have been discussed in detail in the previous Office Action.

'959 teaches the use of octyl palmitate in the cosmetic composition (column 9, lines 55-65). '959 teaches mixtures of polyalkylglucosides in the compositions (column 9, example 14 and column 11 examples 19 and 20, for example). '959 teaches using Montanov 68™ which is taught as being a self emulsifying cetearyl glucoside composition (column 16, lines 35-39 and examples 30 and 34, for example). '959 also

teaches acrylamide/ sodium 2-acrylamido-2-methylpropanesulphonate copolymers as thickeners (column 1, lines 20-35). 25-40% water-in-oil emulsifiers and 75-60% oil-in-water emulsifiers are specified (column 2 lines 48-52). 15-40% oil phase is taught (column 2 lines 54-57). '959 teaches that European legislation might make it impossible to use acrylamide monomers in the future (column 1, lines 36-40).

'034 teaches glucose and xylose residues for the alkylglucoside (column 4, lines 14-20). '034 teaches alkyl chain lengths of 14, 16, 18, 20 and 22 carbon atoms (column 2, lines 35-65). '034 teachs that Montanov 86™ comprises a mixture of polyalkylglucosides (column 1, lines 38-43).

Chaudrey et al. teach a water in oil emulsion containing a polymeric material with monomer components (a) acrylamide; (b) 2-acrylamido-2-methyl-propanesulphonic acid (AMPS) and (c) a crosslinking agent with a molar ratio of (a)/(b) of from 85/15 to 15/85 for providing a thickened composition when formulated (Claim 16). Chaudrey et al. teach "**inverse latex**" polymerization technique (column 1, lines 49-55; column 3, lines 32-35; lines 55-60). Chaudrey et al. teach that mixtures of emulsifiers and other additives can be added before, during or after the polymerization process (column 4, lines 33-48). Chaudrey et al. teach a water in oil inverse emulsion with 60 mol% acrylamide and 40 mol % sodium salt of AMPS crosslinked with MBA to produce an inverse emulsion (column 6, lines 50-67). Chaudrey et al. teach a variety of personal care products with the inverse emulsion (column 7, line 15 through column 9, line 25).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. The difference between the instant application and '959 is that '959 do not expressly teach the crosslinked copolymer of AMPS and acrylamide in a molar ratio between 50/50 and 30/50 in the inverse latex composition. This deficiency in '959 is cured by the teachings of Chaudrey et al.

2. The difference between the instant application and '959 is that '959 do not expressly teach octyl palmitate in the oil phase.

3. The difference between the instant application and '959 is that '959 do not expressly teach R4 in formula II representing octyl, decyl, undecyl, dodecyl, tetradecyl or hexadecyl radical. This deficiency in '959 is cured by the teachings of '034.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use acrylamide/AMPS copolymer of Chaudrey et al. in the inverse emulsion of '959 and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because: 1) the monomer of '959 and the copolymer of Chaudrey et al. both function as thickeners in cosmetic compositions; and 2) '959 suggests the copolymer as a thickener but cautions that potential legislation might make it impossible to use acrylamide in the

composition. However, no such legislation existed at the time of the invention and one of ordinary skill in the art would be free to select that copolymer as suggested by '959.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use octyl palmitate in the inverse emulsion of '959 and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because '959 suggests using plant oil or synthetic oil or mixtures of oils in the oil phase (column 2, lines 58-65) and further disclose a composition with octyl palmitate as discussed above. Therefore, '959 directs one of ordinary skill in the art to using this synthetic oil. Chaudrey et al. establish that additives can be added to the copolymer at any stage of the polymerization process. Thus, in the absence of evidence to the contrary, there is no difference between adding octyl palmitate to the inverse latex composition before or after formulation as a product.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use an alkyl glycoside in the inverse emulsion of '959 and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because: 1) '959 already teaches alkly glycosides in the final composition; and 2) Chaudrey et al. teach that the emulsifying agents can be added before or after polymerization and '034 teaches alkyl polyglycosides as emulsifying agents (column 1, lines 19-20). Thus, in the absence of evidence to the contrary, there is no difference between adding alkyl glycosides to the inverse latex composition before or after formulation as a product.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976).

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to arguments:

Applicant asserts that: "the fact that octyl palmitate is used as an oil phase of a cosmetic emulsion does not constitute an incentive for one of ordinary skill in the art to use octyl palmitate as an oil phase of an inverse latex." And: "The purpose of the oil phase in an inverse latex is to provide the location for a polymerization reaction to occur, i.e., in order to form the inverse latex. On the contrary, the purpose of the oil. phase of a cosmetic formulation does not suffer from any type of chemical reaction." Applicant concludes with: "Thus, the purpose of octyl palmitate in each oil phase is different."

Respectfully, the Examiner cannot agree. As shown below, Example 15 from US 6,375,959 is just a single composition:

EXAMPLE 15

Moisturizing Cream for Greasy Skin

FORMULA		
A	Montanov ™ 68:	5%
	Cetylstearyl octanoate:	8%
	Octyl palmitate:	2%
	Water:	q.s. 100%
	Compound of Example 1:	0.6%
	Micropearl ™ M100:	3.0%
	Mucopolysaccharides	5%

-continued

FORMULA		
	Sepicide ™ HB:	0.8%
	Fragrance:	0.3%

The octyl palmitate must serve as part of the oil phase and be in the location for the chemical reaction to take place because there is only 1 location in the absence of evidence to the contrary. The reference makes it clear when different compositions are mixed to produce the final product. Example 12 from US 6,375,959, reproduced below, exemplifies this.

EXAMPLE 12

Radiant-effect Gel

FORMULA		
A	Compound of Example 1:	4%
	Water:	30%
B	Elastine HPM:	5.0%
C	Micropearl ™ M 100:	3%
	Water:	5%
D	Sepicide ™ CI:	0.2%
	Sepicide ™ HB:	0.3%
	Fragrance:	0.06%
	50% sodium pyrrolidinonecarboxylate:	1%
	Water:	q.s. 100%

Procedure

Prepare A; add B, followed by C and then D.

The expected result remains the same. No unexpected results have been presented. Applicant's arguments are not persuasive and the rejection is maintained.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ernst V Arnold/
Examiner, Art Unit 1616